

UNIFORMED SERVICES UNIVERSITY OF THE HEALTH SCIENCES
PATENT COST-SHARING AGREEMENT

This Agreement is entered into and effective _____, by and between _____ company, institution, party referred to hereinafter as ("THE INSTITUTION), having an address at _____ and the Uniformed Services University for the Health Sciences (USUHS), as represented by the Center for Technology Transfer, having an **address at 4301 Jones Bridge Road, Bethesda, Maryland 20814-4799**.

1. BACKGROUND

- 1.1-- In the course of research programs at USUHS and at THE INSTITUTION, _____ (Inventors) conceived Invention(s) which relate to _____.
- 1.2 -- Any license granted under this Agreement will be subject to a royalty-free, nonexclusive, irrevocable license to the U.S. government to use the Invention(s) for government purposes. The scope of such license shall be as set forth in 37 CFR 4043(a)(2)(i).
- 1.3 -- USUHS and THE INSTITUTION are co-owners of the Invention(s) through the assignment of rights from the Inventors.

2. DEFINITIONS

- 2.1 -- "Invention(s)" means _____ as described in U.S. Patent Application Serial Number _____, and any counterpart foreign patent applications, divisions, or continuations thereof, and any patents issued thereon or reissues or extensions thereof .
- 2.2 -- "Expenses" means all reasonable actual out-of-pocket costs incurred by USUHS for the preparation, filing, and prosecution of U.S. and any foreign patent applications, litigation (except those litigation costs covered by Article 3.6), and the maintenance of resulting patents, exclusive of any salaries, administrative, or other indirect costs.
- 2.3 -- "Recoverable Costs" means fifty percent (50%) of Expenses incurred by USUHS from its management of Invention(s) pursuant to this Agreement plus fifteen (15%) of Expenses.
- 2.4 -- "Center for Technology Transfer (CTT)" means the Uniformed Services University of the Health Science's Center for Technology Transfer.

3. PATENT PROSECUTION AND PROTECTION

- 3.1 -- USUHS or its contractors shall file, prosecute, and maintain all U. S. and any foreign patent application(s), pertaining to the Invention(s) and shall promptly provide to THE INSTITUTION all serial numbers and filing dates, together with copies of all such applications, including copies of all Patent Office actions, responses, and all other Patent Office communications from any Patent Office. In addition, THE INSTITUTION will be granted Power of Attorney on the filing declaration including the right to inspect and copy.
- 3.2 -- USUHS shall make an election with respect to foreign patent application filing, upon consultation with THE INSTITUTION, within eight (8) months of any U.S. patent application filing.
- 3.3 -- USUHS shall promptly record Assignments of patent rights in any Patent Office and shall provide THE INSTITUTION with a photocopy of each recorded Assignment.

- 3.4 -- Notwithstanding any other provision of this Agreement, USUHS shall not abandon the prosecution of any patent application (except for purposes of filing continuation or continuation-in-part applications) or the maintenance of any patent contemplated by this Agreement without prior written notice to THE INSTITUTION at least thirty (30) days prior to the date action must be taken to avoid the abandonment or continue such maintenance. Upon receiving such written notice, THE INSTITUTION may, at their sole option and expense, take over the prosecution of any such patent application, or the maintenance of any such patent.
- 3.5 -- USUHS shall promptly provide to THE INSTITUTION copies of all patents issued which are subject to this Agreement.
- 3.6 -- In the event that USUHS anticipates the possibility of any extraordinary expenditures arising from the preparation, filing, prosecution, or defense of any patent application or patent contemplated by this Agreement, such as opposition or infringement, USUHS shall provide THE INSTITUTION with relevant information and shall discuss with THE INSTITUTION a mutually acceptable course of action prior to incurring such expenditures.
- 3.7-- USUHS or its contractors shall submit to THE INSTITUTION statements of itemized expenses, and if THE INSTITUTION should fail to reimburse USUHS or its contractors for Recoverable Costs within ninety(90)days of receipt of such statements, USUHS may give written notice of default to THE INSTITUTION pursuant to Article 6 of this Agreement. If THE INSTITUTION should fail to repair such default within ninety (90) days from the receipt by it of such notice, USUHS may construe such default as termination on the part of THE INSTITUTION pursuant to Article 10 of this Agreement, except where THE INSTITUTION has identified discrepancies in billing by USUHS, in which case payment for the contested amount may be delayed pending prompt reasonable efforts to resolve the dispute pursuant to Paragraph 5.1 of this Agreement.

4. LICENSING

- 4.1-- THE INSTITUTION and USUHS shall both diligently seek licensee(s) for the commercial development of said Invention(s) and shall administer the Invention(s) for the mutual benefit of the parties and in the best public interest.

5. SETTLING DISPUTES

- 5.1 -- Any controversy or any disputed claim by either party against the other arising under or related to this Agreement shall be submitted jointly to the President of USUHS and to the President of the THE INSTITUTION for resolution. THE INSTITUTION and USUHS will be free after written decisions are issued by those officials to pursue any and all administrative and/or judicial remedies which may be available.

6. NOTICES

Any notice required or permitted to be given to the parties hereto shall be deemed to have been properly given if delivered, in writing, in person or mailed by first-class certified mail to the following addresses, or such other addresses as may be designated in writing by the parties from time to time during the term of this Agreement:

To THE INSTITUTION:

(Name)

(Title)

(Institution/Company Name)

(Street Address)

(City/State and zip code)

To USUHS:

Werten F.W. Bellamy, Sr., J.D.
Director
Center for Technology Transfer
4301 Jones Bridge Road
Bethesda, Maryland 20814-4799

7. WAIVER

It is agreed that no waiver by either party hereto of any breach or default of any of the covenants or agreements herein set forth shall be deemed a waiver as to any subsequent and/or similar breach or default.

8. ASSIGNABILITY

This Agreement is binding upon and shall inure to the benefit of the parties hereto, their successors or assigns, but this Agreement may not be assigned by either party without the prior written consent of the other party.

9. LIFE OF AGREEMENT

This Agreement shall be in full force and effect from the date first herein written and shall remain in effect for the life of the last to expire patent contemplated by this Agreement, unless otherwise terminated by operation of law or by acts of the parties in accordance with the terms of this Agreement.

10. TERMINATION BY INSTITUTION

THE INSTITUTION may terminate this Agreement upon at least sixty (60) days written notice to USUHS, but in any event not less than sixty (60) days prior to the date on which any pending Patent Office actions need be responded to in order to preserve patent rights for the benefit of the parties hereto.
THE INSTITUTION agrees to pay USUHS all Recoverable Costs not previously paid by THE INSTITUTION within thirty (30) days of the termination of this Agreement.

11. TERMINATION BY USUHS

USUHS may terminate this Agreement for any reason upon sixty (60) days written notice to THE INSTITUTION. THE INSTITUTION agrees to pay USUHS all Recoverable Costs not previously paid by THE INSTITUTION within thirty (30) days of the termination of this Agreement.

12. MODIFICATION

Any modification to this agreement must be in writing and agreed to by both parties.

13. SURVIVABILITY

Paragraph USUHS 1.2, 2.3, 3.7, 7, 10, 11, 13 and 14 of this Agreement shall survive termination of this Agreement.

14. COMPLETE AGREEMENT

It is understood and agreed between THE INSTITUTION and USUHS that this Agreement constitutes the entire agreement, both written and oral, between the parties, and that all prior agreements respecting the subject matter hereof, either written or oral, expressed or implied, shall be abrogated, canceled, and are null and void and of no effect. SIGNATURE PAGE IN WITNESS WHEREOF, the parties hereto have executed this Agreement in duplicate originals by their respective duly authorized representative.

FOR USUHS:

Werten F.W. Bellamy, Sr., J.D.
Director
Center for Technology Transfer
4301 Jones Bridge Road
Bethesda, Maryland 20814-4799

FOR THE INSTITUTION: (Upon information and belief, the undersigned expressly certifies or affirms that the contents of any statements of THE INSTITUTION made or referred to in this Agreement are truthful and accurate.)

(Name)

(Title)

(Institution/Company Name)

(Street Address)

(City/State and zip code)